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COLLEEN SZUCH, ESQUIRE
HONEYWELL INTERNATIONAL INC.
101 COLUMBIA ROAD
P.O. BOX 2245
MORRISTOWN NJ 07962

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SEP 20 2004

OFFICE OF PETITIONS

In re Application of :
Basu, Mullan, Scheidle, Bass, and :
Smith :
Application No. 10/687,781 : DECISION REFUSING STATUS
Filed: 17 October, 2003 : UNDER 37 CFR 1.47(a)
Atty Docket No. H0003615 :

This is in response to the petition filed under 37 CFR 1.47(a) on 13 August, 2004.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 17 October, 2003, without an executed oath or declaration. Accordingly, on 21 January, 2004, a Notice to File Missing Parts of Nonprovisional Application was mailed, requiring an executed oath or declaration and a surcharge for its late filing. The Notice was remailed on 11 May, 2004, setting a new two (2) month period for reply.

In response, on 13 August, 2004 (certificate of mailing 11 August, 2004), petitioners filed a one (1) month extension of

time, the present petition, along with a declaration naming Rajat S. Basu, Lawrence F. Mullan, Peter H. Scheile, Steven J. Bass, and Addison M. Smith as joint inventors, signed joint inventors Basu, Mullan, Scheile, and Smith on behalf of themselves and joint inventor Bass.

Petitioners state that a copy of the declaration was sent to the last known address of joint inventor Bass, but that he failed to sign and return the declaration.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

- (3) the petition fee;

- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

- (5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1).

In regards to item (1), petitioners have not provided proof that Bass was ever sent or presented with a copy of the application as filed (specification, including claims, drawings, if any, and the declaration).¹ Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact.

¹MPEP 409.03(d).

Additionally, if Bass no longer lives at the last known address, petitioners may show diligent efforts (e.g., by use of Internet or other database searches) to determine a current address for the non-signing inventor. If a more recent address is discovered, petitioners should send or give a copy of the application papers to the inventor at that address.

If the envelope sent to the non-signing inventor at the last known address is returned as undeliverable by the post office, petitioners should provide a copy of the envelope showing that the application was returned as undeliverable with any renewed petition. If the inventor refuses in writing to sign, a copy of that written refusal should be provided with any renewed petition. If the inventor refuses orally, petitioners should submit details of the refusal in an affidavit or declaration of facts by a person having first-hand knowledge of the refusal.

If repeated attempts to contact the non-signing inventor are unsuccessful, petitioners will have shown that despite diligent efforts, the inventor could not be reached.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 220 20th Street S.
 Customer Window, Mail Stop Petition
 Crystal Plaza 2, Lobby, Room 1B03
 Arlington, VA 22202

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.


Douglas I. Wood
Senior Petitions Attorney
Office of Petitions